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DOCKET NO.: C1039.70083US05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Krieg et al.  
Serial No.: 10/789,536  
Confirmation No.: 9640  
Filed: February 26, 2004  
For: IMMUNOMODULATORY OLIGONUCLEOTIDES  
Examiner: Nita M. Minnifield  
Art Unit: 1645

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 16<sup>th</sup> day of March, 2007.

  
Jamieson K. Herrick

MAIL STOP AMENDMENT

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following documents:


- Information Disclosure Statement
- PTO Form 1449 with cited references
- Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 646-8000, Boston, Massachusetts.

A check in the amount of \$180.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to Deposit Account 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,

By:

  
Helen C. Lockhart, Ph.D., Reg. No.: 39,248  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
Telephone: (617) 646-8000

Docket No.: C1039.70083US05  
Date: March 16, 2007  
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Jamieson K. Herrick

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**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT FILED PURSUANT TO THE DUTY OF  
DISCLOSURE UNDER 37 CFR §§1.56, 1.97 AND 1.98**

Sir:

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, the Applicant requests consideration of this Information Disclosure Statement.

**PART I: Compliance with 37 C.F.R. §1.97**

This Information Disclosure Statement has been filed more than three months after the filing date of this application and after the mailing date of the first Office action, but before the mailing date of any final action under 37 C.F.R. §1.113, a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in this application.

The fee of \$180.00 as set forth in 37 C.F.R. §1.17(p) is enclosed.

PART II: Information Cited

The Applicant hereby makes of record in the above-identified application the information listed on the attached form PTO-1449 (modified PTO/SB/08). The order of presentation of the references should not be construed as an indication of the importance of the references.

The Applicant hereby makes the following additional information of record in the above-identified application.

The Applicant would like to bring to the Examiner's attention the following co-pending applications that may contain subject matter related to this application:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Inventor(s)</u>	<u>Docket No.</u>
11/595,823	11-10-2006	Wagner et al.	*C1041.70035US01
11/598,207	11-10-2006	Krieg et al.	*C1039.70048US24
11/603,978	11-22-2006	Forsbach et al.	*C1041.70053US02
11/629,106	12-08-2006	Lipford et al.	*C1041.70027US01
11/645,106	12-22-2006	Krieg et al.	*C1039.70083US17

\*A copy of this reference is not provided as the Office has waived the requirement under 37 C.F.R. 1.98(a)(2)(iii) for submitting a copy of a cited U.S. patent application if it is scanned to the Image File Wrapper system and is available on Private PAIR.

The Applicant would like to bring to the Examiner's attention the following other information, whose relevance is discussed in Part III below:

PART III: Explanation of Non-English Language References and Remarks Concerning Other Information Cited

The following are remarks concerning the other information cited:

The instant patent application derives priority from US 6,194,388 B1, which is a priority application for US 6,207,646 B1, which was involved in Interference No. 105171. In view of the priority, Applicants have included on the attached 1449 a listing of all of the motions filed, the judgment rendered by the Board of Patent Appeals and Interferences, appeal briefs, and appeal decision, which considered the 35 U.S.C. §135(b)(1) motion dispositive. Copies of these documents were previously submitted in Serial No. 10/690,495, filed October 21, 2003, to which the instant application derives priority. If the Examiner would like any additional information on this subject, she is encouraged to contact Applicant's representative at the number listed below.

#### PART IV: Remarks

Documents cited anywhere in the Information Disclosure Statement are enclosed unless otherwise indicated. It is respectfully requested that:

1. The Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims;
2. The enclosed form PTO-1449 (modified PTO/SB/08) be signed by the Examiner to evidence that the cited information has been fully considered by the Patent and Trademark Office during the examination of this application;
3. The citations for the information be printed on any patent which issues from this application.

By submitting this Information Disclosure Statement, the Applicant makes no representation that a search has been performed, of the extent of any search performed, or that more relevant information does not exist.

By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

Serial No.: 10/789,536  
Conf. No.: 9640

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Art Unit: 1645

By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.

Notwithstanding any statements by the Applicant, the Examiner is urged to form his or her own conclusion regarding the relevance of the cited information.

An early and favorable action is hereby requested.

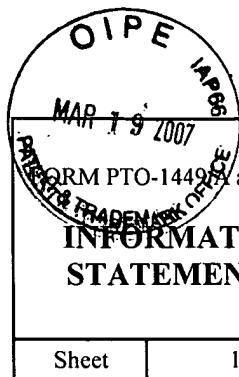
Respectfully submitted,

By:



Helen C. Lockhart, Ph.D., Reg. No. 39,248  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
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FORM PTO-1449 and B (modified PTO/SB/08) <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				APPLICATION NO.: 10/789,536	ATTY. DOCKET NO.: C1039.70083US05
				FILING DATE: February 26, 2004	CONFIRMATION NO.: 9640
				APPLICANT: Krieg et al.	
				GROUP ART UNIT: 1645	EXAMINER: Nita M. Minnified
Sheet	1	of	4		

#### U.S. PATENT DOCUMENTS

Examiner's Initials #	Cite No.	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication or Issue of Cited Document MM-DD-YYYY
		Number	Kind Code		
		5,849,719		Carson et al.	12-15-1998
		6,174,872	B1	Carson et al.	01-16-2001
		6,399,630	B1	Macfarlane	06-04-2002
		2002-0086839	A1	Raz et al.	07-04-2002
		2003-0027782	A1	Carson et al.	02-06-2003
		2004-0006034	A1	Raz et al.	01-08-2004
		2004-0092468	A1	Schwartz et al.	05-13-2004
		2006-0241076	A1	Uhlmann et al.	10-26-2006
		2006-0246035	A1	Ahluwalia et al.	11-02-2006
		2006-0286070	A1	Hartmann et al.	12-21-2006
		2006-0287263	A1	Davis et al.	12-21-2006
		2007-0009482	A1	Krieg et al.	01-11-2007
		2007-0010470	A1	Krieg et al.	01-11-2007
		2007-0037767	A1	Bratzler et al.	02-15-2007

#### FOREIGN PATENT DOCUMENTS

Examiner's Initials #	Cite No.	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Translation (Y/N)
		Office/ Country	Number	Kind Code			

#### OTHER ART – NON PATENT LITERATURE DOCUMENTS

Examiner's Initials #	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Translation (Y/N)
		LEIBSON et al., Role of gamma-interferon in antibody-producing responses. Nature. 1984 Jun 28-Jul 4;309(5971):799-801.	
		WHALEN et al., DNA-mediated immunization to the hepatitis B surface antigen. Activation and entrainment of the immune response. Ann N Y Acad Sci. 1995 Nov 27;772:64-76.	
		YAMAMOTO, Cytokine production inducing action of oligo DNA. Rinsho Meneki. 1997; 29(9): 1178-84. Japanese.	Yes
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 3 (for judgment based on failure to comply with 35 U.S.C. 135(b)). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 4 (for judgment of no interference in fact). (Electronically filed, unsigned). June 7, 2004.	

EXAMINER:	DATE CONSIDERED:
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# EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

<b>FORM PTO-1449/A and B (modified PTO/SB/08)</b>  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				APPLICATION NO.: 10/789,536		ATTY. DOCKET NO.: C1039.70083US05	
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				APPLICANT: Krieg et al.			
				GROUP ART UNIT: 1645		EXAMINER: Nita M. Minnified	
Sheet	2	of	4				

	*	Patent Interference No. 105,171. Iowa Preliminary Motion 5 (for judgment based on lack of enablement). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 6 (for judgment based on lack of adequate written description). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 7 (motion to redefine interference to designate claims as not corresponding to the Count). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 8 (contingent motion to redefine the Count). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 9 (motion for benefit of earlier application). (Electronically filed, unsigned). June 7, 2004.	
	*	Patent Interference No. 105,171. Iowa Preliminary Motion 10 (contingent motion to redefine the interference by adding a continuation application). (Electronically filed, unsigned). July 2, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 3 (to Iowa Preliminary Motion 3 for judgment under 35 USC 135(b)). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 4 (to Iowa Preliminary Motion 4 for judgment of no interference in fact). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 5 (to Iowa Preliminary Motion 5 for judgment that UC's claim is not enabled). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 6 (to Iowa Preliminary Motion 6 for judgment based on lack of adequate written description). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 7 (to Iowa Preliminary Motion 7 to redefine the interference). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 8 (to Iowa Preliminary Motion 8 to redefine the Count). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Response 9 (to Iowa Contingent Motion 9 for benefit). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 10 (to Iowa Contingent Motion 10 to redefine the interference). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Opposition 11 (to Iowa Contingent Motion 11 to suppress). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 3 (in support of Iowa Preliminary Motion 3 for judgment under 35 U.S.C. §135(b)) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 4 (in support of Iowa Preliminary Motion for judgment of no interference in fact) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 5 (in support of Iowa Preliminary Motion 5 for judgment that UC's claim 205 is not enabled) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 6 (in support of Iowa Preliminary Motion 6 for judgment based on lack of adequate written description) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 7 (in support of Iowa Preliminary Motion 7 to redefine the interference) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 8 (in support of Iowa Preliminary Motion 8 to redefine the count) (Electronically filed, unsigned). October 15, 2004.	

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	*	Patent Interference No. 105,171. Iowa Reply 10 (in support of Iowa Preliminary Motion 10 to redefine the interference) (Electronically filed, unsigned). October 15, 2004.	
	*	Patent Interference No. 105,171. Iowa Reply 11 (in support of Iowa Miscellaneous Motion to suppress). (Electronically filed, unsigned). October 18, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Statement. June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 1 (to designate additional claims of Iowa patent as corresponding to the Count). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 2 (for judgment based on lack of written description support and introducing new matter). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 3 (for judgment based on anticipation). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 4 (for judgment based on obviousness). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 5 (for judgment based on anticipation). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Preliminary Motion 6 (for judgment based on inequitable conduct). June 7, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Contingent Preliminary Motion 7 (for benefit of an earlier application under 37 CFR 1.633(j)). July 2, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Contingent Preliminary Motion 8 (to add additional claims under 37 CFR 1.633(c)(2) and (i)). July 2, 2004.	
	*	Amended Claims for Application Number 09/265,191, filed March 10, 1999.	
	*	Patent Interference No. 105,171. Iowa Opposition 1 (opposition to motion to designate additional claims as corresponding to the Count) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 2 (opposition to motion for judgment based on lack of written description support and introducing new matter) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 3 (opposition to motion for judgment based on anticipation) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 4 (opposition to motion for judgment based on obviousness) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 5 (opposition to motion for judgment based on anticipation) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 6 (opposition to motion for judgment based on inequitable conduct) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 7 (opposition to motion for benefit of an earlier application under 7 CFR 1.633(j)) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Iowa Opposition 8 (opposition to motion to add additional claims under 37 CFR 1.633 (2) and (i)) (Electronically filed, unsigned). September 9, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Reply 1 (to Iowa's opposition to UC's motion to designate Iowa claims as corresponding to the Count). October 15, 2004.	

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	*	Patent Interference No. 105,171. Regents of the University of California Reply 2 (to Iowa's opposition to UC Preliminary Motion 2 for Judgment). October 15, 2004.	
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	*	Patent Interference No. 105,171. Regents of the University of California Reply 4 (to Iowa's Opposition to UC Preliminary Motion 4 for Judgment). October 15, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Reply 5 (to Iowa's Opposition to UC Preliminary Motion 5 for Judgment). October 15, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Reply 6 (to Iowa's opposition to UC Preliminary Motion 6 for judgment). October 15, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Reply 7 (to Iowa's Opposition to UC Preliminary Motion 7 for Benefit). October 15, 2004.	
	*	Patent Interference No. 105,171. Regents of the University of California Reply 8 (to Iowa's Opposition to UC Preliminary Motion 8 to add additional claims). October 15, 2004.	
	*	Patent Interference No. 105,171. Decision on Motion under 37 CFR §41.125. March 10, 2005.	
	*	Patent Interference No. 105,171. Judgment and Order. March 10, 2005.	
	*	Patent Interference No. 105,171. Regents of the University of California. Brief of Appellant. July 5, 2005.	
	*	Patent Interference No. 105,171. University of Iowa and Coley Pharmaceutical Group, Inc. Brief of Appellees. August 17, 2005.	
	*	Patent Interference No. 105,171. Regents of the University of California. Reply Brief of Appellant. September 6, 2005.	
	*	Patent Interference No. 105,171. Regents of the University of California. Decision of CAFC. July 17, 2006.	

\*a copy of this reference is not provided as it was previously cited by or submitted to the office in a prior application, Serial No. 10/690,495, filed October 21, 2003, and relied upon for an earlier filing date under 35 U.S.C. 120 (continuation, continuation-in-part, and divisional applications).

[NOTE – No copies of U.S. patents, published U.S. patent applications, or pending, unpublished patent applications stored in the USPTO's Image File Wrapper (IFW) system, are included. See 37 CFR §1.98 and 1287OG163. Copies of all other patent(s), publication(s), unpublished, pending U.S. patent applications, or other information listed are provided as required by 37 CFR §1.98 unless 1) such copies were provided in an IDS in an earlier application that complies with 37 CFR §1.98, and 2) the earlier application is relied upon for an earlier filing date under 35 U.S.C. §120.]

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